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David Allison Bennett

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EXAMINER

PLUCINSKI, JAMISUE A

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6

7  
8 *Ex parte* DAVID ALLISON BENNETT,  
9 SCOTT MEYER, PAUL BILIBIN,  
10 JINYUE LIU, and GARY RHOE INGRAM  
11

12  
13 Appeal 2009-009088  
14 Application 09/685,078  
15 Technology Center 3600  
16

17  
18 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
19 ANTON W. FETTING, *Administrative Patent Judges*.  
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE<sup>2</sup>

David Allison Bennett, Scott Meyer, Paul Bilibin, Jinyue Liu, and Gary Rhoe Ingram (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-6, 28-33, 49-52, and 58, which along with claims 59-65 withdrawn from consideration, are the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a parcel shipping management system (Specification 1:20-21).

An understanding of the invention can be derived from a reading of exemplary claims 51 and 1, which are reproduced below [bracketed matter and some paragraphing added].

51. A shipping management computer system, said computer system comprising at least one computer device, wherein said shipping management computer system is programmed to:

simultaneously identify to a respective user of a plurality of users,

in response to the respective user's request

for at least one delivery notification service option

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed July 21, 2008) and Reply Brief ("Reply Br.," filed December 16, 2008), and the Examiner's Answer ("Ans.," mailed October 16, 2008).

1 of a plurality of delivery notification service  
2 options for shipping a respective parcel,  
3 each delivery service offered  
4 by each respective carrier of a  
5 plurality of carriers  
6 that would support each  
7 delivery notification service  
8 option  
9 requested by the respective user for delivery  
10 of the respective parcel.

11 1. A server-based shipping management computer system, said  
12 server-based shipping management computer system  
13 comprising

14 [1] at least one server computer device, wherein said server-  
15 based shipping management computer system is programmed  
16 to:

17 [2] receive

18 from a particular user client computer device  
19 of a plurality of user client computer devices,  
20 a request input by a user for an electronic mail delivery  
21 notification service by a carrier system  
22 for shipping a particular parcel and  
23 an input by the user of parcel specifications for the  
24 particular parcel;

25 [3] for each respective carrier of a plurality of carriers,

26 determine whether the respective carrier would provide  
27 electronic mail delivery notification

28 for shipping the particular parcel according to the  
29 request; and

30 [4] for each respective carrier

31 of the plurality of carriers that would provide  
32 electronic mail delivery notification for shipping  
33 the particular parcel according to the request,

display to a display device configured for communication  
with the particular user client computer device of the  
user,

as to the particular parcel,

a simultaneous identification of shipping charges  
for each delivery service offered by the respective  
carrier

to ship the particular parcel according to the parcel  
shipping specifications.

The Examiner relies upon the following prior art:

Pauly	US 4,958,280	Sep. 18, 1990
Nicholls	US 5,485,369	Jan. 16, 1996
Fisher	US 6,047,264	Apr. 4, 2000
Kara	US 6,233,568 B1	May 15, 2001

Intershipper Finds Cheapest Shipping Rates, Internet Update, Newsbytes  
Claims 1-6, 49-52, and 58 stand rejected under 35 U.S.C. § 103(a) as  
unpatentable over Nicholls, Fisher, Kara, and Intershipper.

Claims 28-33 stand rejected under 35 U.S.C. § 103(a) as unpatentable  
over Nicholls, Pauley, Kara, and Intershipper.

## ISSUES

The issue of obviousness turns on whether it was predictable to  
determine which carriers offered various delivery notification services and  
simultaneously display the charges for those services.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to Claim Construction*

01. The disclosure contains no lexicographic definition of “verbal.”

02. The ordinary and customary meaning of “verbal” encompasses (1) of, in, or by means of words: a verbal image; (2) concerned merely with words, as distinguished from facts, ideas, or actions; or (3) in speech; oral rather than written: usage objected to by some.<sup>3</sup>

*Facts Related to the Prior Art*

*Nicholls*

03. Nicholls is directed to computerized systems for expediting the shipping of goods in commerce. Nicholls 1:6-7.

04. Nicholls shows several special services options for delivery in Fig. 4A. Among those options is getting proof of delivery, which a form of delivery notification.

*Kara*

05. Kara is directed to accounting for the pick-up, shipping and delivery of articles. Kara 1:48-56.

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<sup>3</sup> Webster’s New World College Dictionary (2010)  
<http://www.yourdictionary.com/verbal>.

1           06. In order to present the user with information from which to  
2           choose a particular shipping service provider by which to ship the  
3           piece, Kara's program may calculate the fees associated with the  
4           available shipping service providers. The user may select  
5           shipping service providers in order to allow the program to  
6           determine the fees for only those shipping service providers, and  
7           then calculate and display fees according to the desired shipping  
8           and/or delivery parameters, i.e., class, urgency, etc. Where a  
9           selected shipping service provider does not provide a desired  
10          shipping and/or delivery parameter, Kara may indicate such and  
11          provide the fees for a service offered by that particular shipping  
12          service provider most near that desired by the user. Additionally,  
13          Kara may indicate other ones of the shipping service providers  
14          which do not provide a desired shipping and/or delivery parameter  
15          and provide the fees for a service offered by that particular  
16          shipping service provider most near that desired by the user, as  
17          well as indicate how their service differs from that desired. Kara  
18          22:21-48.

19          *Fisher*

20          07. Fisher is directed to providing customer status updates. Fisher  
21          1:11-13.

22          08. Fisher provides a service of providing order status by electronic  
23          mail. Fisher 1:56-61.

1 *Pauly*

2           09.   Pauly is directed to the fulfillment of contact lenses. Pauly 1:6-

3           10.

10. Pauly describes a customer service representative providing an oral telephonic indication of order status after seeing the status from Pauly's system. Pauly 9:34-38.

7      *Intershipper*

11. Intershipper is directed to reporting a new service for retrieving  
shipping rates from all major shippers. Intershipper: ¶ 1-2.

10           12.   Intershipper retrieves information describing every method  
11               possible that one can use to ship a package and arranges results in  
12               cost order.

13 ANALYSIS

There are basically two variations of the invention in the independent claims. Both variations are for systems that get parcel data, determine whether each carrier would provide some service, and simultaneously display the shipping charges for that parcel for each carrier that would provide that service. In claims 1, 49-52, and 58, the service is an electronic mail delivery notification; while claim 28 recites a verbal delivery notification instead. Claims 51 and 52 are the broadest forms, claim 51 being a system and claim 52 being a method, and do not recite receiving the initial data or displaying shipping charges, but displaying each delivery service option that would support a customer's request.



1       The Examiner found that one of ordinary skill would have found the  
2       claimed inventions predictable because Nicholls describes using a shipping  
3       system to get information, and describes a notification service as one of  
4       several shipping services offered, Kara describes determining whether each  
5       carrier would provide some service and Intershipper shows displaying all of  
6       the carriers and the information regarding a parcel requested for each carrier.  
7       The Examiner found Fisher describes electronic mail delivery confirmation  
8       and Pauly describes oral such confirmation. Ans. 4-7.

9       The Appellants presented two broad arguments expressed as five issues  
10      in the Appeal Brief at 20-53. The Examiner responded to those arguments at  
11      Ans. 8-17. We find that the Examiner persuasively rebutted the Appellants'  
12      Appeal Brief arguments and we adopt the Examiner's findings of fact and  
13      analysis and reach the same legal conclusions. Thus we now address the  
14      Appellants' Reply Brief in which the same five issues were supplemented.

15      Issues 1, 2, and 4 argue that the art fails to show that it was predictable  
16      to determine or identify carriers that would provide the requested delivery  
17      notification services for shipping a particular parcel. Issue 4 more  
18      specifically identifies the service as verbal delivery notification.

19      As the Examiner found, all of the references use some form of shipping  
20      system. FF 03, 05, 07, 09, 11. Nicholls in particular accepts information  
21      regarding a particular package and accepts service selections including  
22      delivery notification. FF 03 & 04. Fisher shows that this notification may  
23      be by electronic mail and Pauly shows this notification may be oral.

24      Much of the Appellants' specific contentions argue that none of the  
25      references show the option for delivery service as in Nicholls being by way

1 of either electronic mail or oral delivery. The Examiner did not, however,  
2 find that a single reference anticipated the claims, but rather that one of  
3 ordinary skill would have found the combination a predictable one. As both  
4 electronic mail and oral delivery are shown in the references to be among the  
5 known methods of providing delivery notification, implying there are more  
6 than one such methods, it was predictable for one to augment Nicholls input  
7 of delivery notification with a further selection as to the specific medium the  
8 notification would be made in.

9 One further point regarding the claim 28 limitation “verbal delivery  
10 notification service” is in order. The word verbal is both broad and  
11 ambiguous. The adjective “verbal” may refer to being of, in, or by means of  
12 words, or it may refer to being oral. The Examiner clearly relied on Pauly to  
13 show that oral delivery was predictable. But the scope of the limitation also  
14 encompasses any delivery service made using words, as in Fisher’s email, or  
15 even the conventional post card notification known to most users of the  
16 postal service.

17 Thus this issue reduces to whether Kara showed it was predictable to  
18 determine whether each respective carrier would provide electronic mail or  
19 verbal delivery notification. Since delivery notification was shown to be a  
20 known and used service option, with both electronic mail and oral delivery  
21 as known media, as we found *supra*, this issue further reduces to whether  
22 Kara showed it was predictable to determine whether each respective carrier  
23 would provide a specific service option.

24 Kara is given a list of carriers and a set of shipping and delivery  
25 parameters and determines which of the carriers meet the parameters.

1 Where one of the carriers does not meet the parameters, Kara *may* indicate  
2 such and show the parameters that most closely match and indicate the  
3 parameter difference. FF 06. Thus, Kara determines whether each  
4 respective carrier would provide a specific service option as indicated by the  
5 parameters. Whether Kara specifically describes delivery notification as an  
6 example of such an option does not diminish Nicholls' evidence that  
7 delivery notification was an option that would be encompassed within the set  
8 of predictable parameters for Kara.

9 The Appellants also contend that Kara does not show that a carrier  
10 would not be displayed if the carrier did not provide the service requested.  
11 Reply Br. 18. To this two findings are relevant. The first is that Kara  
12 merely says that the display *may* include those carriers that do not provide  
13 the service, implying the display *may not*. Thus, not displaying those  
14 carriers is within the implicit description of Kara. The second finding is that  
15 none of the claims preclude displaying those carriers that do not provide the  
16 service. So long as those carriers that do provide the service are displayed,  
17 the claim limitations are met.

18 Two sub-issues are identified by the Appellants in both issues 1 and 4,  
19 viz. (1) failure to describe specifically including delivery notification as  
20 among the criteria determined in the art and (2) that Fisher simply sends an  
21 electronic mail rather than determining whether to send such a message. As  
22 to the first sub-issue, as we found *supra*, delivery service options were a  
23 predictable species of the parameters described by Kara. As to the second  
24 sub-issue, as we found *supra*, Fisher was simply evidence that electronic  
25 mail was a known medium for Nicholls' delivery notification. Once  
26 Nicholls showed it was known to include delivery service as an option, and

1 it was shown there were multiple media that such notification could take, it  
2 was predictable to further query as to which medium to use.

3 Issues 3 and 5 argue that the art fails to show that it was predictable to  
4 simultaneously display shipping charges for those carriers meeting the  
5 delivery notification criteria for either each delivery service offered to ship  
6 the particular package (claims 1, 28, 49, and 58) or for the delivery  
7 notification charges (claims 50-52). The Appellants' argument comes down  
8 to the fact that Intershipper does not explicitly state that the results are  
9 displayed simultaneously or that what is displayed are the charges for each  
10 option. Since we found *supra* that it was predictable to display shipping  
11 charges for those carriers meeting the delivery notification criteria, this issue  
12 and these arguments reduce to whether it was predictable to display each  
13 such charge and to do so simultaneously.

14 The Examiner applied Intershipper to show this simultaneity.  
15 Intershipper retrieves information describing every method possible that one  
16 can use to ship a package and arranges results in cost order. FF 12. Since  
17 the results are exhaustive and arranged in cost order, the arrangement  
18 necessarily requires all the applicable charges and that the results be  
19 displayed simultaneously. Thus we agree with the Examiner that it was  
20 predictable to provide the display results simultaneously.

21 Whether Intershipper specifically describes using delivery notification  
22 charges as the costs that are used does not diminish the finding that it was  
23 predictable to display shipping charges for those carriers meeting the  
24 delivery notification criteria. We also find that it was at least predictable to  
25 one of ordinary skill to display each service charge applicable to the package

1 as such information is clearly pertinent to the shipper's ultimate selection.  
2 Having established the simultaneity of displaying information to make a  
3 decision, it was predictable to include any information clearly pertinent  
4 towards that decision.

#### 5 CONCLUSIONS OF LAW

6 Rejecting claims 1-6, 49-52, and 58 under 35 U.S.C. § 103(a) as  
7 unpatentable over Nicholls, Fisher, Kara, and Intershipper is not in error.

8 Rejecting claims 28-33 under 35 U.S.C. § 103(a) as unpatentable over  
9 Nicholls, Pauley, Kara, and Intershipper is not in error.

#### 10 DECISION

11 To summarize, our decision is as follows.

- 12 • The rejection of claims 1-6, 49-52, and 58 under 35 U.S.C. § 103(a) as  
13 unpatentable over Nicholls, Fisher, Kara, and Intershipper is  
14 sustained.
- 15 • The rejection of claims 28-33 under 35 U.S.C. § 103(a) as  
16 unpatentable over Nicholls, Pauley, Kara, and Intershipper is  
17 sustained.

18  
19 No time period for taking any subsequent action in connection with this  
20 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
21 § 1.136(a)(1)(iv) (2007).

AFFIRMED

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5 mev

6

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